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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,290	11/25/2003	Thomas Koithan	WEAT/0310	5565
36735	7590	01/27/2006	EXAMINER	
PATTERSON & SHERIDAN, L.L.P. 3040 POST OAK BOULEVARD, SUITE 1500 HOUSTON, TX 77056			DANG, HOANG C	
			ART UNIT	PAPER NUMBER
			3672	

DATE MAILED: 01/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/723,290	<b>Applicant(s)</b> KOITHAN ET AL.	
	<b>Examiner</b> Hoang Dang	<b>Art Unit</b> 3672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>5/5/04, 5/12/04, and 5/17/04</u>  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 6, 11, 22 and 23 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Vincent et al (US Re. 34,063) (see column 1, line 63 through column 2, line 46; column 3, lines 23-53; column 4, lines 14-39 and 51-57; column 5, lines 16-25; column 5, line 65 through column 6, line 6; column 6, line 57 through column 7, line 6; and column 9, lines 31-68).

As for claim 6, see column 3, lines 23-35).

As for claims 22-23, see column 5, line 39 through column 6, line 18.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2-5, 7-10, 12-21 and 24-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vincent et al ('063) in view of McCombs et al (US 4,365,402) or Okada et al (US 5,402,688) or Weiner et al (US 4,091,451).

Vincent et al disclose the invention as claimed except that Vincent et al monitors torque as a function of time, rather than turns of threaded tubular members being made up whereas the claims call for monitoring torque and turns. However, it is well known in the art to monitor torque and turns of tubular members being made up to prevent damage to the threaded connection as evidenced by Vincent et al (column 1, lines 25-27) or McCombs et al (column 2, lines 1-59) or Okada et al (column 2, lines 43-49) or Weiner et al (column 1, lines 51-60). It would have been a matter of choice and obvious to one of ordinary skill in the art at the time the invention was made to use torque and turns rather than torque and time to control the making up of a threaded connection of Vincent et al in view of the teaching of Vincent et al (column 1, lines 25-27) or McCombs et al or Okada et al or Weiner et al for the advantage pointed out above.

As for claim 29, see column 3, lines 23-35.

As for claim 35, see column 10, lines 18-28 and 36-44.

5. Claims 26 and 36-39 and rejected under 35 U.S.C. 103(a) as being unpatentable over Vincent et al ('063) in view of McCombs et al ('402) or Okada et al ('688) or Weiner et al ('451) as applied to claim 24 above, and further in view of Bromell (3,662,842) or Juhasz et al (US 6,443,241).

Vincent et al, as modified by McCombs et al ('402) or Okada et al ('688) or Weiner et al ('451), disclose the invention as claimed except that Vincent et al disclose that their apparatus can be mounted to any suitable type of threaded pipe connecting apparatus, generally referred to in the petroleum industry as power tongs (column 3, lines 38-45) whereas the claims call for a top drive. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to mount the apparatus of Vincent et al as modified by McCombs et al or

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Okada et al or Weiner et al to a top drive as claimed because it is known in the art to use a top drive unit to connect or disconnect pipe sections as evidenced by Bromell (see figures 2-5 and column 3, lines 17-32 and column 4, lines 3-9) or Juhasz et al (column 6, lines 34-47).

### *Double Patenting*

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1, 10, 11 and 13-15 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 41-45, 48-50, 52-58, 74, 75 and 81-88 of copending Application No. 10/389,483. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application are broader and therefore read on the invention as defined by claims 41-45, 48-50, 52-58, 74, 75 and 81-88 of copending Application No. 10/389,483.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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8. Claims 2-9, 12 and 16-45 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 41-45, 48-50, 52-58, 74, 75 and 81-88 of copending Application No. 10/389,483 in view of Vincent et al (US Re. 34,063). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the threaded members of the claimed invention of copending application 10/389,483 with a shoulder seal whose condition is monitored during the making up of the threaded connection in view of the teaching of Vincent et al '063. It would also have been obvious to use a computer to control and/or monitor the making up of threaded connection in view of Vincent et al in order to minimize human errors.

This is a provisional obviousness-type double patenting rejection.

### ***Conclusion***

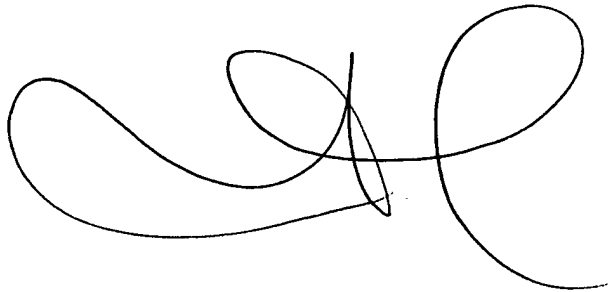
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoang Dang whose telephone number is 571-272-7028. The examiner can normally be reached on 9:15-5:45 Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoang Dang  
Primary Examiner  
Art Unit 3672

A handwritten signature in black ink, consisting of a series of loops and a long horizontal stroke, positioned below the printed name and title.